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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,772	11/02/2001	Toshio Ueno	01706/LH	4311

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EXAMINER

ZURITA, JAMES H

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/002,772	Applicant(s) UENO, TOSHIO	
	Examiner James H Zurita	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-12,15-22 and 25-33 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1, 4-12, 15-22 and 25-33 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/27/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant amendment of 22 November cancelled claims 2, 3, 13, 14 and 23, 24.

Applicant amended claims 1, 4-12, 15-22 and 25-33.

Claims 1, 4-12, 15-22 and 25-33 are pending and will be examined.

Response to Arguments

Claim objections and rejections of same under 35 USC 101 are withdrawn in view of amendment. Corrected drawings are accepted. Amendments to the Specification are noted.

Applicant's arguments concerning rejection under 35 USC 103 have been very carefully and thoroughly considered but are not persuasive.

In response to applicant's argument that Squalia is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

Applicant amended claims 1, 12 and 22 from "...accessing a product..." to "...accessing an image forming apparatus..." As noted in the prior office action, the type of apparatus, or the label applied by applicant does not in itself.

Squeglia does not use the term image forming apparatus. *Squeglia* does not refer to various executable instructions by applicant's labels, including order issuing

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part, as in claim 5, product selecting part, as in claim 5, order information providing part, as in claim 7, delivery schedule information providing part, as in claims 5 and 7, product information providing part, as in claims 5 and 7.

However, the labels given to various actors and modules are not functionally related to the substrate of the article of manufacture. The labels themselves carry little or no patentable weight. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply a label to various actors and modules in a system such as Squeglia because such data does not functionally relate to the substrate of the article of manufacture and merely labeling the data differently from that in the prior art would have been obvious. See *Gulack* cited above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-12, 15-22 and 25-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Squeglia et al. (US PG-PUB 2002/0156692 A1).

As per claims 1, 12 and 22, Squeglia discloses methods, systems and computer-executable instructions for coping changes in hardware including:

- **accessing** a product of (a railcar, for example) a user through a network and acquiring information on the product of the user. See, for example, at least paragraph 23 and Fig. 1.
- **acquiring** information on a part to be changed. See, for example, at least paragraph 24 and other references to parts such as locomotive systems, subsystems, assemblies.
- **generating** information on a product that requires change of a part, from the information on the product of the user and the information on the part to be changed. See, for example, at least paragraph 25, 26 and 28. See also other references to repair recommendations.
- **Providing** the information on the apparatus that require the part change to a terminal operated by a maintenance administrator. See, for example, at least Paragraph 2, and Fig. 1, for references to service shop(s) on a network.
- **calculating** a number of parts to be changed based on the information on the product that requires change of the part. See, for example, at least paragraph 35 and references to calculating parts based on information such as repair actions, fault codes, and others.

As per claims 4, 15 and 25, Squeglia discloses generating order data on the part to be changed from the calculated number of parts to be changed. See, for

example, at least paragraph 39 concerning generating maintenance and repair work orders.

As per claims 5, 16 and 26, Squeglia discloses transmitting the order data to a service parts system. See, for example, at least Paragraph 2, Fig. 1 and other related text for references to Parts requisition centers, MDSC Monitoring and Diagnostic Service Center. These systems are inter-connected and order data is communicated.

As per claims 6, 17 and 27, Squeglia discloses that acquired information on the part to be changed includes solution information, and the solution information is notified to the equipment owned by the person in charge of service along with the information on the product that requires change of the part. See, for example, at least paragraph 26 and references to problem resolution suggestions and repair actions.

As per claims 7, 18 and 28, Squeglia discloses that information on the product of the user includes a product manufacture number. See, for example, references to equipment information by model number. Locomotives are sold by particular model numbers. See also references to locomotive identification number.

As per claims 8 and 19, Squeglia discloses that information on the product of the user includes information on an option configuration. See, for example, at least paragraphs 6 -9.

As per claim 9, Squeglia discloses that information on the product of the user includes information on a network configuration. See, for example, at least paragraph 9, concerning networks. See also paragraph 23 concerning types of links to a network.

Such information allows a user to connect in various ways to networks. See also references to wireless networks, paragraph 54.

As per claims 10, 21 and 29, Squeglia discloses that information on the product of the user includes usage condition information. See, for example, references to condition-based maintenance, paragraph 2 and others.

As per claims 11, 20 and 30, Squeglia discloses that information on the product of the user includes software information. See, for example, at least paragraph 40 concerning software version configuration.

As per claims 31-33, Squeglia discloses that software information is software version information. See, for example, at least paragraph 40 concerning software version configuration.

As per claims 1, 4-12, 15-22 and 25-33, Squeglia **does not** specifically refer to *image forming apparatus*, *apparatus information acquiring section*, *a change information acquiring section*, *an information generating section* (claim 12).

However, the labels given to various actors and modules are not functionally related to the substrate of the article of manufacture. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply a label to various actors and modules in a system such as Squeglia because such data does not functionally relate to the

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substrate of the article of manufacture and merely labeling the data differently from that in the prior art would have been obvious.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to track any type of product or apparatus, including image forming apparatus. One of ordinary skill in the art at the time the invention was made would have been motivated to track any type of product or apparatus, including image forming apparatus, for the obvious reason that businesses often need to allocate resources as needed, perhaps by not carrying and storing inventory, thereby releasing money for other purposes.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James Zurita
Patent Examiner
Art Unit 3625
28 February 2005


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